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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/878,302	06/11/2001	Todd O. Bolken	4717US (00-0979)	3287
24247	7590	10/01/2004	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			MITCHELL, JAMES M	
			ART UNIT	PAPER NUMBER
			2813	

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/878,302

Applicant(s)

BOLKEN, TODD O.

Examiner

James M. Mitchell

Art Unit

2827

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-19 and 29-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20,21 and 23-26 is/are rejected.
- 7) ☒ Claim(s) 22,27 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/11/01</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1- 17, drawn to a product, classified in class 257, subclass 679.
- II. Claims 18, 19 and 29-39, drawn to apparatus, classified in class 164, subclass 137.
- III Claims 20-28, drawn to a method, classified in class 438, subclass 15.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, such as without a step of forcibly moving the substrate.

Inventions I and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case the product as claimed can be made by another and materially different apparatus/ assembly, such as a molding cavity without wing cavities.

Inventions II and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case) the process as claimed can be practiced by another materially different apparatus, such as an apparatus without the second plate having through holes outside of the molding structures.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Likewise, because these inventions are distinct for the reasons given above and the search required for Group II is not required for Groups I and II, restriction for examination purposes as indicated is proper.

During a telephone conversation with James Duzan on August 10, 2004 a provisional election was made without traverse to prosecute the invention of Group III, claims 20-28. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-19 and 29-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

Art Unit: 2813

F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 20, 21 and 24-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 5, 12, 20, 22, 22, 27, 31, 53, 58 of U.S. Patent No. 6,764,882. Although the conflicting claims are not identical, they are not patentably distinct from each other because while applicant's pending claim are broader than the patent both are generally drawn to the same method of making a card wherein a substrate is connected to a strip or frame by connecting portions and the substrate in a molding assembly is pushed to a level different than the strip or frame..

Claims 20, 21 and 24-26 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 10, 15, 17, 19, 20, 22, 23, 27, 29, 50,51,52,58 and 75-78 of U.S. Patent No. 6,444,501. Although the conflicting claims are not identical, they are not patentably distinct from each other because while applicant's pending claim are broader than the patent both are generally drawn to the same method of making a card wherein a substrate is connected to a strip or frame by connecting portions and the substrate in a molding assembly is pushed to a level different than the strip or frame

Claims 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1, 5, 12, 20, 22, 27, 31, 53, 58 of U.S. Patent No. 6,764,882 in view of Miyamoto (U.S. 4,910,582) and Ibiden (JP 07-171786). Although U.S. Patent 6,764,882 does not appear to show pins passing through downset throughholes in said mold assembly to move the segments attached to the substrate.

Miyamoto (Fig. 2) utilizes a plurality of sprocket holes passing in a mold assembly.

Ibiden (Fig 2,3) utilizes pins passing through downset throughholes/ sprocket holes of a carrier.

It would have been obvious to one of ordinary skill in the art to incorporate sprocket holes in the mold assembly of Patent 6,764,882 as shown in Miyamoto, such that pins pass through downset through holes in the carrier to convey material/carrier strip as taught by Ibiden (English Title & Abstract) and therefore provide mass fabrication.

Claims 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1, 2, 5, 10, 15, 17, 19, 20, 22, 23, 27, 29, 50, 51, 52, 58 and 75-78 of U.S. Patent No. 6,444,501. in view of Miyamoto (U.S. 4,910,582) and Ibiden (JP 07-171786). Although U.S. Patent 6,444,501 does not appear to show pins passing through downset throughholes in said mold assembly to move the segments attached to the substrate.

Miyamoto (Fig. 2) utilizes a plurality of sprocket holes passing in a mold assembly.

Ibiden (Fig 2,3) utilizes pins passing through downset throughholes/ sprocket holes of a carrier.

It would have been obvious to one of ordinary skill in the art to incorporate sprocket holes in the mold assembly of Patent 6,444,501 as shown in Miyamoto, such that pins pass through downset through holes in the carrier to convey material/carrier strip as taught by Ibiden (English Title & Abstract) and therefore provide mass fabrication.

Allowable Subject Matter

Claim 22, 27, 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art does not disclose or make obvious moving the substrate a distance of about 0.2-3 times the substrate thickness or the removal of the molding assembly by inserting pins into a downset throughholes including all the limitations of the independent claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Mitchell whose telephone number is (571) 272-1931. The examiner can normally be reached on M-F 8:00-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl Whitehead Jr. can be reached on (571) 272-1702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jmm
September 28, 2004


ERIK KIELIN
PRIMARY EXAMINER